



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/466,155	06/06/95	PUBLI	104098-0007-1

D3M1/0528
TOWNSEND AND TOWNSEND KHOURIE AND CREW
STEUART STREET TOWER
ONE MARKET PLAZA
SAN FRANCISCO CA 94105

NAKARAN	EXAMINER
ART UNIT	PAPER NUMBER
1216	5

DATE MAILED:

05/28/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No. 08/466,155	Applicant(s) Buhl et al
Examiner D. S. Nakarani	Group Art Unit 1316



Responsive to communication(s) filed on Jun 6, 1995

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ----- month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claims 1-32 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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15.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-16, 20 and 21 are, drawn to a method, classified in Class 435, subclass 6+.

II. Claims 17-19, 22-28 and 32 are, drawn to a composition, classified in Class 428, subclass 402.

16.

III. Claims 29-31 are, drawn to a package, classified in Class 206, subclass 52.

17.

The inventions are distinct, each from the other because of the following reasons:

18.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, such as flash freezing the drops.

19.

Inventions III and II are related as combination and

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subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination does not require bead form of dried chemical. The subcombination has separate utility such as forming tablets.

20.

The Invention I and the Invention III are independent and distinct from each other because the Invention I is directed to a process of making beads while the Invention III is directed to a container containing dried chemical composition. The dried chemical composition is not in the form of beads.

21.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for either Group II or Group III, restriction for examination purposes as indicated is proper.

22.

A telephone call was made to Kevin L. Bastian on May 14 and 15, 1996 to request an oral election to the above restriction

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requirement, but did not result in an election being made.

23.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

24.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

25.

Any inquiry concerning this communication should be directed to D.S. Nakarani at telephone number (703) 308-2351.


D. S. NAKARANI
PRIMARY EXAMINER
GROUP 1300

D.S. Nakarani:jp
May 23, 1996